

Remarks

Claims 1-9 and 19-28 were pending prior to this Response with claims 5 and 19-28 having been withdrawn. By the present communication, no new claims have been added, no claims have been canceled, and claims 1, 2 and 6 have been amended to define Applicants' invention with greater particularity. Support for the amendments may be found throughout the specification and claims as originally filed. No new matter has been added. Accordingly, upon entry of the present amendment, claims 1-4, 6-9, and 18 will be pending and under consideration in this application.

Election/Restriction

The Office Action indicates that claims 5 and 19-28 have been withdrawn and that the requirement for species election is deemed proper in spite of Applicants previously submitted arguments. Applicant asserts that restricting the claims to a specific binding carrier and plant oil or wax unduly limits the scope of protection sought. As mentioned throughout the Description, any suitable binding carriers can be selected for use in the present invention, provided that the polyphenol is adsorbed to the binding carrier. Further, an anhydrous topical composition in accordance with the present invention can optionally comprise a cream, gel or ointment which can comprise a saturated or unsaturated plant oil or wax.

Applicants reserve the right to pursue prosecution of the non-elected inventions and/or species upon an indication of allowance of the generic claims or in a later filed application claiming the benefit of priority of the above-identified application.

Objection to the Claims

Claims 2 and 6 have been objected to on the basis of allegedly containing various informalities. Without acquiescing to the reasoning offered by the Office Action, and in order to expedite prosecution of the instant application, Applicants have amended claims 2 and 6 as suggested by the Office. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection under 35 U.S.C. §112, 2nd Paragraph

Applicants respectfully traverse the rejection of claims 1-4, 6-9 and 18 under 35 U.S.C. §112, 2nd paragraph as allegedly being indefiniteness.

In particular the Office Action asserts that the claims are indefinite for recital of the phrase “consisting of” since the language is closed claim language and additional components are recited in the claims. Without acquiescing to the reasoning offered by the Office Action, and in order to expedite prosecution of the instant application, Applicants have amended claim 1 to recite “comprising” as opposed to “consisting of” obviating the rejection. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 20-23 under 35 U.S.C. §102(b) as allegedly being anticipated by Xiong et al. (U.S. 6,299,925; hereinafter “Xiong”).

To anticipate, a single reference must inherently or expressly teach each and every element of the claimed invention. *In re Spada*, 15 USPQ2d 1655 (Fed Cir. 1990); and *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131.

Applicants note that Xiong is directed to an effervescent green tea extract formulation. The formulation is used by dispensing it in water (or another suitable liquid) and waiting until it is disbursed or dissolved. Once the formulation has become substantially dissolved or disbursed in the liquid it is orally consumed (see col. 3, lines 36-37 and col. 5, lines 37-38 and 43-46). However, Xiong neither teaches nor discloses a topical composition, let alone one in which a polyphenol is adsorbed to a binding carrier. In contrast to the present invention, the formulation in Xiong is for oral consumption.

Further, the Office appears to acknowledge that Xiong does not expressly teach that the tea plant extract is adsorbed onto the binding carrier as presently claimed, but alleges that the claimed functional properties are inherent to the preparation. However, adsorption to the binding carrier is required for even disbursement of the polyphenol within the composition (see page 2 of

the present description). Such a feature would not be required in an oral formulation, and particularly not in the oral formulation of Xiong, since the formulation is dissolved in water before being consumed. Even if the polyphenol was evenly disbursed within the solid formulation of Xiong, there would be no requirement for the polyphenol to be adsorbed to a binding carrier, since any even distribution in the solid formulation would be disrupted upon dissolution.

Therefore, Applicants submit that Xiong does not anticipate claims 1-4 and requests withdrawal of the rejection.

Rejections under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-4, 6-9 and 18 under 35 U.S.C. §103(a) as allegedly obvious over Xiong in view of Hall et al. (WO 03/063840; hereinafter "Hall").

The U.S. Supreme Court decision in *KSR International v. Teleflex Inc.* (82 USPQ 2d 1385), modified the standard for establishing a *prima facie* case of obviousness. Under the *KSR* rule, three basic criteria are considered. First, some suggestion or motivation to modify a reference or to combine the teachings of multiple references still has to be shown. Second, the combination has to suggest a reasonable expectation of success. Third, the prior art reference or combination has to teach or suggest all of the recited claim limitations. Factors such as the general state of the art and common sense may be considered when determining the feasibility of modifying and/or combining references.

The new Guidelines establishing standards for obviousness emphasize that Examiners "must provide a reasoned explanation as to why the invention as claimed would have been obvious," and are equally clear that "familiar lines of argument," e.g., a showing of unexpected results, a lack of reasonable expectation of success, and a teaching away from the claimed invention by the prior art, can still demonstrate the nonobviousness of a claimed invention. Applicants submit that the Examiner has not met this burden for the reasons discussed below.

The teaching of Xiong is discussed above. With regard to Hall, Applicants note that Hall is directed to a composition for delivery of proton pump inhibitors. The composition disclosed in Hall comprises an antacid core. Applicants assert that the composition in Hall is intended for transmucosal delivery of the proton pump inhibitors in the mouth. However, Hall does not teach or suggest a topical composition as presently claimed, nor one in which a polyphenol is adsorbed to a binding carrier. Hall fails to cure the deficiencies of Xiong.

It is axiomatic that one cannot simply use the Applicant's disclosure as a "blueprint" to reconstruct, by hindsight, Applicant's claim. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). As the cited references fail to teach or suggest all of the recited claim limitations, the Office Action fails to establish a *prima facie* case of obviousness against the presently claimed invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested

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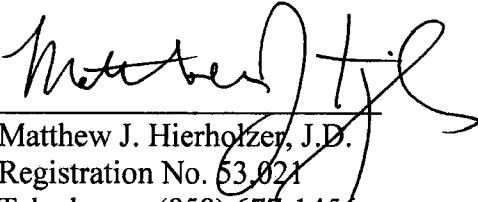
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ATTY. DOCKET NO.: OSLER1140-1

CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable consideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge the amount of \$550.00 to cover the payment of a Three-Month Extension of Time fee, small entity. Additionally, the Commissioner is authorized to charge any other fees associated with the filing submitted herewith, or credit any overpayments to Deposit Account No. 07-1896 referencing the above-identified attorney docket number.

Respectfully submitted,


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